

REMARKS

The Office Action mailed May 6, 2004 has been reviewed and the comments of the Patent and Trademark Office have been considered. Claims 1 and 3-22 were pending in the application. Claims 1 and 20 have been amended, claim 22 has been cancelled and no claims have been newly added. Therefore, claims 1 and 3-21 are pending in the application. Applicants respectfully request entry of and reconsideration based on the instant amendment and reply because it is believed to place the application in condition for allowance.

This amendment changes and deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

In the Office Action, claims 1, 3-17, and 20-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,486,686 to Zdybel et al. (hereafter "Z '686"), further in view of U.S. patent 6,400,392 to Yamaguchi et al. (hereafter "Yamaguchi"). Claims 18 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Z '686 and Yamaguchi, further in view of U.S. patent 5,444,779 to Daniele (hereafter "Daniele"). Applicants respectfully traverse these rejections for at least the following reasons.

Independent claims 1 and 20 recite a method (and system) in which, *inter alia*, a voice input is received indicative of an annotation or processing instruction for an electronic document, and a mark is placed on the hardcopy of the document that includes the annotation or processing instruction for the document that is received by voice input. Thereafter, when an image of the hardcopy is captured and the mark is decoded to retrieve the electronic document, the retrieved electronic document is processed according to the annotation or processing instruction for the document received from the voice input. At least this recited feature is not disclosed or suggested by the applied prior art.

In particular, applicants note that the Office Action asserts, in paragraph 3, that claim 22 does not recite voice input annotation or processing be embodied in the mark placed on the hardcopy. Pending independent claims 1 and 20 now explicitly recite this feature whereby claim 22 has now been cancelled. Furthermore, the portion of Z '686 cited against this feature in the Office Action (with respect to then pending claim 22) clearly does not disclose

or suggest this feature. Specifically, col. 6, lines 44-49 cited in the Office Action relates only to input devices for creating or editing the electronic documents. Z '686 teaches that such input devices may include other input devices for inputting voice data for creating or manipulating the electronic documents. There is no teaching or suggestion of the claimed voice input of annotation or processing information that is embodied in a mark placed on the hardcopy corresponding to the electronic document. Accordingly, there is also no teaching or suggestion of the further processing of the retrieved electronic document (identified by the mark on a hardcopy) according to the processing information (in the mark) received from the voice input. Therefore, at least these claimed features are not disclosed or suggested by Z 686.

Furthermore, since the deficiencies in Z '686 are not cured by any of the other applied references, the pending independent claims 1 and 20 are patentable over the applied prior art.

The dependent claims are also allowable for at least the same reasons as the independent claims 1 and 20 on which they ultimately depend. In addition, they recite additional patentable features when considered as a whole.

Applicants respectfully request entry of and reconsideration based on the instant amendment and reply because it is believed to place the application in condition for allowance. If there are any questions regarding the application or if an examiner's amendment would facilitate the allowance of one or more of the claims, the examiner is courteously invited to contact the undersigned attorney at the local number below.

Respectfully submitted,

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By

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